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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
INGVOLDSTAD, BENNETT				
ART UNIT		PAPER NUMBER		
2427				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/518,502

Applicant(s)

TSUNOKAWA ET AL.

Examiner

Bennett Ingvaldstad

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/2009 has been entered.

Response to Arguments

Applicant's arguments filed 10 April 2009 have been fully considered.

Applicant traverses the examiner's previous assertion that "[t]he specification provides no support for receiving the file **from** a recording and playback apparatus" by citing to step S42 of Figure 13 and the following paragraph from pages 30 and 31:

When it is determined that the search mode based on characteristic words is selected, the process proceeds to step S42. The recording/reproducing apparatus 3 issues an instruction to the server 2 connected to the network 1 so as to supply the characteristic word file 103.

Figure 13, step S42 and the above paragraph describe the recording/reproducing apparatus sending an instruction requesting that the server provide the characteristic word file to the recording/reproducing apparatus at step S31 as illustrated. A request that a file be sent **to** the device is not the same as sending the file **from** the device, as explained in the 112 rejections. The above citations support the examiner's assertions

that the specification does not support the claim. Therefore, the argument is not persuasive and the previous 112 rejections stand.

Further, the examiner submits that in any case Figure 13 cannot be relied upon to support the subject matter of claim 13, since claim 13 describes four separate devices as well as a recording and reproducing apparatus, whereas Figure 13 only illustrates a server, a recording/reproducing apparatus, and a television receiver, thus totaling only three devices including the recording and reproducing apparatus.

Applicant further requests a clarification of why the Patel reference was used in the rejection of claim 16, but not claim 15, since the claims "differ only in the preambles thereof." Remarks at 7. The Patel reference is not applied to the claims 13-15 rejections because claims 13-15 refer to an apparatus comprising several devices and a method respectively. These claims are not limited to a single device and are thus met by Knudson's plurality of devices as described in the rejections. However, claim 16 refers to a single computer readable medium, thus implying that a single device meets all of the limitations. Since Knudson teaches a plurality of devices meeting the limitations, the claim 16 rejection was modified with the Patel reference to demonstrate that a single computer readable medium meeting the limitations was obvious.

Claim Rejections - 35 USC § 112

Claims 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 13 describes an apparatus comprising a first device, an input device, a device, and a second device. The second device receives "...information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus...." However, the examiner finds no support in the specification for a second device that receives a characteristic word transmitted from a recording and playback apparatus. Referring specifically to Figure 13, step S31, the characteristic word is transmitted **from** a server 2 **to** a recording and playback apparatus 3. The specification provides no support for receiving the word **from** a recording and playback apparatus at a second device. Therefore, the claim contains new matter.

Claim 14 further describes a first device for receiving "a file containing information about said characteristic word from said recording and playback apparatus". Referring to Figure 13, step S31, the characteristic word file is transmitted **from** a server 2 **to** a recording and playback apparatus 3. The specification provides no support for receiving the file **from** a recording and playback apparatus. Therefore, the claim contains new matter.

The same argument as above applies further to claim 15, which contains identically language requiring the reception of a characteristic word from a recording and playback apparatus.

Claim 16 describes "controlling reception of a file containing information about a characteristic word representing a characteristic of a television program". Again referring to Figure 13, step S31, the characteristic word file is transmitted **from** a server 2 **to** a recording and playback apparatus 3. Therefore, since claim 16 describes receiving a characteristic word file, the specification only provides support for the computer program of claim 16 being executed by the recording and playback apparatus 3 of Figure 13.

However, the claim goes on to describe "controlling transmission of information ... to a recording and playback apparatus". The specification provides no support for transmitting information from a recording and playback apparatus to a recording and playback apparatus. Therefore, the claim contains new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Knudson (US 2006/0095937).

Knudson teaches:

Claim 13: An information processing apparatus comprising:

a first device (user equipment) configured to receive a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television programs are classified [0053]);

an input device (remote control) configured to allow a user to select an intended characteristic word from characteristic words contained in said file (remote control 42 [Fig 1] for selecting displayed categories [0056]);

a device (server) configured to transmit information about a characteristic word selected by said user to a recording and playback apparatus (a server with a database 24 performs a search of program guide information and transmits the search results back to the user equipment [0062]; user equipment may be a recording and playback apparatus [0040]); and

a second device (television) configured to receive television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (a television 40 [Fig 1] displays the search results for the user [0063]).

Knudson teaches:

Claim 15: An information processing method comprising:

controlling reception of a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television program are classified [0053]);

allowing a user to select an intended characteristic word from characteristic words contained in said file (selecting a category from the list [0056]);

controlling transmission of information about a characteristic word selected by said user to a recording and playback apparatus (a server with a database 24 performs a search of program guide information and transmits the search results back to the user equipment [0062]; user equipment may be a recording and playback apparatus [0040]); and

controlling reception of television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (user equipment receives search results after transmitting a search query comprising a characteristic word to a server with database 24 [0062]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson (US 2006/0095937) in view of Patel (US 2004/0078829).

Knudson teaches:

Claim 16 (Currently Amended): A computer readable medium encoded with a computer program to allow a computer to perform:

controlling reception of a file containing information about a characteristic word representing a characteristic of a television program (user equipment receives from the headend a list of categories by which television program are classified [0053]);

allowing a user to select an intended characteristic word from characteristic words contained in said file (selecting a category from the list [0056]);

controlling transmission of information about a characteristic word selected by said user to [an] apparatus (search information comprising a characteristic word is transmitted to server with database 24 for performing the search [0063]); and

controlling reception of television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (receiving the search results from the server [0063]).

Knudson does not teach that the headend server to which information about a characteristic word is transmitted is a recording and playback apparatus.

Patel teaches that a headend may be a recording and playback apparatus [0015].

It would have been obvious to have modified Knudson's headend to have been a recording and playback apparatus for the purpose of providing video on demand [Patel 0015].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bennett Ingvaldstad whose telephone number is (571)270-3431. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bennett Ingvaldstad/

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Examiner, Art Unit 2427

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427